

Page 16, lines 10-30, amend the paragraphs as follows.

Referring to FIG. 17, on the lower display 12, a Free Spin Bonus is triggered by a STAR symbol 72 on the first and fifth reels 30 and 34 in any position in the basic slot game. In the Free Spin Bonus, the STAR symbols animate into a “wild” STAR symbol that is wild for all symbols except the HOLLYWOOD SQUARES symbol. Also, the player is awarded a random or predetermined number of free spins of the second, third, and fourth reels 31, 32, and 33, while the first and fifth reels 30 and 34 containing the STAR symbols remain locked (do not spin). For example, the number of free spins may always be five or may be randomly selected to be in the range from five to ten. After each spin, as in the basic slot game the player is awarded a payout for any winning combinations along active pay lines. FIG. 18 illustrates such a winning combination along pay line 43 on the lower display 12. The amount of the payout is determined by the pay table employed in the basic slot game. Upon completion of the Free Spin Bonus, the CPU shifts operation back to the basic slot game.

Referring to FIG. 19, a Secret “X” Bonus game on the lower display 12 may be triggered by another start-bonus outcome in the basic slot game. In the Secret “X” Bonus game, the display depicts a tic-tac-toe array of locations (squares) 80 individually selectable by a player. An animated celebrity is illustrated in each location 80. The tic-tac-toe array includes three columns 82a, 82b, and 82c with three locations 80 in each column. A secret “X” is associated with one of the three locations 80 in the second column 82b. The player is prompted to select one of the remaining six locations 80 in the first and third columns 82a and 82c for placement of a free “X”:

#### **REMARKS**

Claims 1-23 remain in the application for further prosecution.

The Examiner alleges that Bennett discloses the invention in claims 1-10, except that it is missing a processor that becomes more intelligent with each turn. The Examiner relies upon Orak for this missing limitation, however, and alleges, “[i]t would have been obvious . . . to incorporate into Bennett a processor that becomes more intelligent with each turn . . .” The Applicants respectfully disagree on the basis that significant claim features and limitations are missing from Orak. One of the basic requirements of a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. The missing claim features and limitations are addressed below.

#### **1. Not All Claim Limitations Taught Or Suggested**

Bennett discloses, “. . . *the game is an interactive game where the player plays against the machine, or possibly another player. In one embodiment the game is tic-tac-toe and the player accumulates prizes for each square selected and wins prizes by winning the game.*” (Page 2, lines 26-29.) Bennett is silent with respect to how the machine interactively plays against the player. Bennett is also silent with respect to varying the skill level of the game.

The Examiner cites Orak, which states, “[i]n the other preferred embodiment, one player may also play against the microcontroller. This embodiment has four levels for such play. In one level, the controller selects its spaces at random. In another level, the computer evaluates possible selections based on possible outcomes one complete player turn into the future. In other, more sophisticated levels, the computer evaluates based on outcomes two or three complete player turns into the future.” (Column 5, lines 36-44.) Orak further states, “. . . the electronic game has two playing modes, one which may be played by one human player against another, and one in which the microcontroller makes the space selections for one of the players. In the later of these modes, the microcontroller may be set on one of two skill

*levels for providing the appropriate challenge to both novice players and expert players.”*

(Column 4, lines 60-67.) Specifically, as noted above, Orak states, “*the microcontroller may be set on one of two skill levels,*” indicating that these skill levels are not variable during game play. It is apparent based on these paragraphs that Orak does not contemplate varying the skill level during the course of the game. Orak only discloses changing the skill level between games.

In contrast, claims 1-10 of the application require “*a probability of using a winning strategy for the selections by the processor varying with successive ones of the selections by the processor.*” (Page 20, line 1, to page 21, line 22.) This probability is explained in the specification as “[t]he probability of using a winning strategy for the selections by the processor increases with successive ones of the selections by the processor so that the processor appears to become more intelligent as the game progresses.” (Page 3, lines 10-13.) Claims 1-10 basically describe a game wherein the processor can vary the probability of using a winning strategy during the play of the game, while the game is progressing. This is in sharp contrast with Orak, which can only change the skill level, or level of play, between games. Orak does **not** vary the “*probability of using a winning strategy . . . with successive . . . selections by the processor.*” (Claims 1-10.) Orak limits a specific game to a specific skill level.

If the Examiner wishes to maintain the obviousness rejection with respect to the claimed features clearly missing from Bennett and Orak, the Applicants respectfully request that the Examiner cite appropriate references that disclose such features. *See* MPEP 2144.03.

#### **B. Claims 11-18**

Claims 11-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoseloff (U.S. Patent No. 6,312,334) in view of Hollywood Squares (King World Productions) and further in view of Anderson Associates.

The Examiner alleges that it would have been obvious to incorporate into Yoseloff the teachings of Hollywood Squares and Anderson Associates. The Applicants respectfully disagree on the basis that significant claim features and limitations are missing from Hollywood Squares. One of the basic requirements of a *prima facie* case of obviousness is that the prior art references must teach or suggest all of the claim limitations. The missing claim features and limitations are addressed below.

**1. Not All Claim Limitations Taught Or Suggested**

Claims 11-18 require “*providing a trivia question; randomly selecting an answer to the trivia question.*” (Page 21, line 24, to page 23, line 9.) Claim 15 similarly states, “*means for providing a trivia question and randomly selecting an answer to the trivia question.*” (Page 22, lines 16-26.) This element for “*randomly selecting an answer to the trivia question*” is missing from both Yoseloff and Hollywood Squares.

Hollywood Squares has two competing players. Further, Hollywood Squares has elements of skill associated with game play as the two competing players have the opportunity to agree or disagree with the answers provided to the trivia questions provided. A player’s correct assessment of an answer to the trivia question allows the player to capture the square. An incorrect assessment of the answer causes the player to lose that square to his competitor. Hollywood Squares teaches the active involvement of the player to evaluate an answer to the trivia question. Hollywood Squares is silent with respect to “*randomly selecting an answer to the trivia question.*”

Yoseloff only mentions Hollywood Squares in passing and teaches “*placing a wager to participate in a first video wagering game having a first screen format representing a game show (e.g., Let’s make a Deal®, The Price Is Right®, Wheel of Fortune®, Jeopardy®,*

*Hollywood Squares®*, or any game having the visual appearance of a game show, as with a stage, participants, host/hostess, audience, marquee, etc.” (Column 8, lines 1-7.) Yoseloff is also silent with respect to “*randomly selecting an answer to the trivia question.*”

The invention of claims 11-18 is in sharp contrast to the proposed combination of Yoseloff and Hollywood Squares. The invention of claims 11-18 essentially allows the player to passively watch the game as it progresses. The player is not required to agree or disagree with the answer provided. As claim 11 states, “*providing a trivia question; randomly selecting an answer to the trivia question.*” (Page 20, lines 28-29.) Claim 15 similarly states, “*means for providing a trivia question and randomly selecting an answer to the trivia question.*” (Page 21, lines 21-22.) Hollywood Squares is silent with respect to “*randomly selecting an answer to the trivia question.*”

If the Examiner wishes to maintain the obviousness rejection with respect to the claimed features clearly missing from Bennett and Orak, the Applicants respectfully request that the Examiner cite appropriate references that disclose such features. *See* MPEP 2144.03.

### **C. Claims 19-23**

Claims 19-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoseloff in view of Secret X and further in view of Anderson Associates.

The Examiner alleges that it would have been obvious to incorporate the Secret X game into Yoseloff. The Applicants respectfully disagree. With regard to the proposed combination of Yoseloff and Secret X, in order for any references to be validly combined for use in a prior art § 103 rejection, *the references themselves* must suggest that they be combined.

**1. Yoseloff And Secret X Do Not Contain Any Justification To Support Their Combination**

Secret X does not provide any suggestion or motivation for its combination with Yoseloff, nor does Secret X provide any suggestion that the game could potentially be used in a gaming machine.

Yoseloff is also silent with respect to any information regarding Secret X. Yoseloff makes no mention of Secret X nor suggests any application of Secret X to a wagering environment such as in a gaming machine. It is true that Yoseloff suggests one of the many games played on The Price is Right as one of the segments of Yoseloff's wagering game. The game described by Yoseloff in connection with the Price Is Right, however, is as follows:

*placing a wager to participate in a first video wagering game having a first screen format representing a game show (e.g., Let's make a Deal®, The Price Is Right®, Wheel of Fortune®, Jeopardy®, Hollywood Squares®, or any game having the visual appearance of a game show, as with a stage, participants, host/hostess, audience, marquee, etc; (column 8, lines 1-7);*

*a second screen format is used in the play of the second segment, which second screen format is visually different from the first screen format and also represents a segment of a game show (e.g., where the first segment engages play of a spiling wheel to match numbers or total points closest to a target value when spinning the wheel and the second segment screen format has multiple door selection or matches symbols and/or values, as in an alternative to matching prices with specific products as done on The Price is Right®, and the second screen format is used in the play of a different wagering game than that played in said first segment; (column 8, lines 18-31).*

It is apparent that the Price is Right video gaming segments described by Yoseloff make no mention of Secret X. In fact, Yoseloff proposes the idea of using the Price is Right, which entails matching prices to products, which is fundamentally different from Secret X. Yoseloff proposes “*spiling wheel to match numbers or total points closest to a target value when spinning the wheel and the second segment screen format has multiple door selection or matches symbols and/or values, as in an alternative to matching prices with specific products*

*as done on The Price is Right®.*” This is a different game than that described in claims 19-23. On this basis, it is apparent that Yoseloff actually teaches away from the invention of claims 19-23. Surely, Yoseloff’s mere mention of applying a game show theme to a video wagering segment cannot preclude (render obvious) any and all inventions claiming wagering games based on a particular game play methodology such as Secret X.

Yoseloff broadly proposes that gaming machines can be developed with a thematic approach utilizing game shows. *“The play of segments in sequence which have an art (especially including the entertainment art) recognized relationship is referred to herein as ‘thematic continuity.’”* (Column 7, lines 48-51.) Such statements, however, are extremely general and lack sufficient specificity to suggest the combination of Secret X and Yoseloff.

Because neither Yoseloff nor Secret X provides any motivation or suggestion for combining the cited references used in this rejection, the Applicants maintain that the combination of references cited to form this rejection is improper. Any conclusion to the contrary is based on impermissible hindsight using the Applicants’ own teachings. Although “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning,” the Applicants respectfully submit that the judgment of obviousness in this case is taking into account knowledge gleaned from the Applicants’ disclosure instead of knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made.

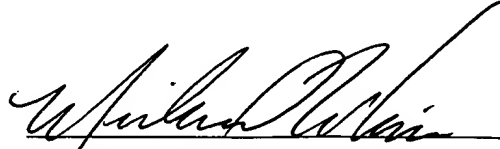
## **Conclusion**

It is the Applicants’ belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview,  
the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

Date: December 26, 2002

A handwritten signature in cursive script, appearing to read "Michael L. White", written over a horizontal line.

Michael L. White  
Reg. No. 39,421  
(773) 961-1267  
Attorney for Applicants





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Pay Table

X Win

50 CREDITS AND  
QUESTION ROUND

Tie Game










20 CREDITS AND  
CELEBRITY PICK

Win

20 CREDITS

SELECT A  
CELEBRITY  
TO PLAY  
TIC TAC TOE

HOLLYWOOD  
squares

 JOAN RIVERS	 BRAD GARRETT	 GEORGE WALLACE
 DON RICKLES	 WHOOPI GOLDBERG	 PAT MORITA
 PHYLLIS DILLER	 GILBERT GOTTFRIED	 BRUCE VILANCH

LINE BET

1

CREDITS

892

BONUS

0

PAID

0




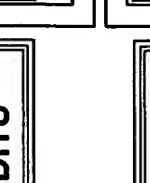



FIG. 9

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<b>Pay Table</b> <b>X Win</b> <b>50 CREDITS AND QUESTION ROUND</b> <b>Tie Game</b> <b>20 CREDITS AND CELEBRITY PICK</b> <b>O Win</b> <b>20 CREDITS</b>	 JOAN RIVERS O	 BRAD GARRETT X	 GEORGE WALLACE O
	 DON RICKLES X	 WHOOP! GOLDBERG X	 PAT MORITA X
	 PHYLLIS DILLER X	 GILBERT GOTTFRIED O	 BRUCE VILANCH O

**50 CREDITS WON**

**HOLLYWOOD squares**

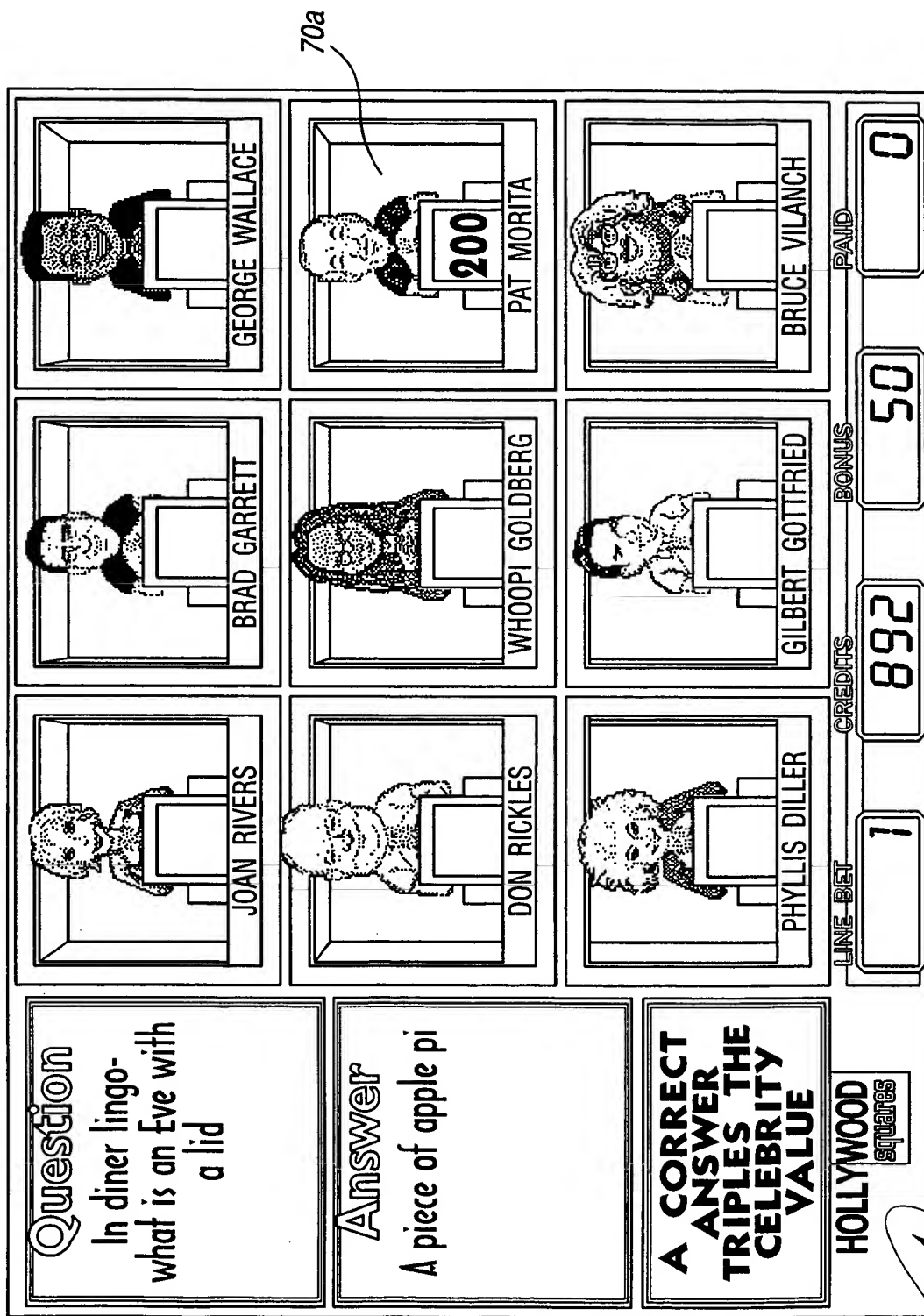
LINE BET	CREDITS	BONUS	PAID
1	892	50	0

**FIG. 10**

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A circular black ink stamp from the OIPF Patent &amp; Trademark Office. The text "OIPF" is at the top, "JAN 06 2003" is in the center, and "PATENT &amp; TRADEMARK OFFICE" is at the bottom.

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**FIG. 11**

21



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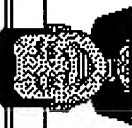
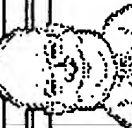
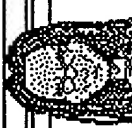




<b>Question</b> In diner lingo- what is an fve with a lid	 100 JOAN RIVERS	 90 BRAD GARRETT	 60 GEORGE WALLACE
<b>Answer</b> A piece of apple pi	 50 DON RICKLES	 50 WHOOPI GOLDBERG	 200 PAT MORITA
<b>CORRECT</b> 600 CREDITS WON	 80 PHYLLIS DILLER	 50 GILBERT GOTTFRIED	 70 BRUCE VILANCH
<b>A CORRECT ANSWER TRIPLES THE CELEBRITY VALUE</b>	LINE BET	CREDITS	BONUS
HOLLYWOOD squares	1	892	650
			PAID
			0

FIG. 12

12



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Pay Table

X Win

50 CREDITS AND QUESTION ROUND

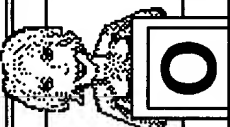

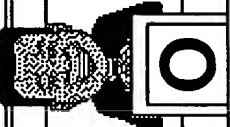




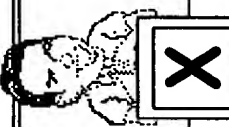
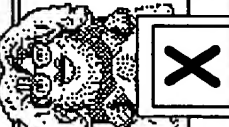
Tie Game

20 CREDITS AND CELEBRITY PICK

Win

20 CREDITS

20 CREDITS WON

<div>JOAN RIVERS</div> <div></div> <div>O</div>	<div>BRAD GARRETT</div> <div></div> <div>O</div>	<div>GEORGE WALLACE</div> <div></div> <div>O</div>
<div>DON RICKLES</div> <div></div> <div>O</div>	<div>WHOOPI GOLDBERG</div> <div></div> <div>X</div>	<div>PAT MORITA</div> <div></div> <div>X</div>
<div>PHYLLIS DILLER</div> <div></div> <div></div>	<div>GILBERT GOTTFRIED</div> <div></div> <div>X</div>	<div>BRUCE VILANCH</div> <div></div> <div>X</div>

LINE BET

1

CREDITS

844

BONUS

20

PAID

0

HOLLYWOOD squares

12

FIG. 13



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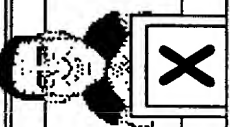
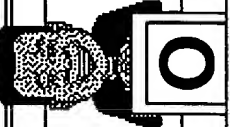



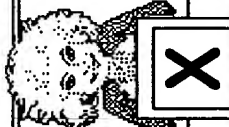

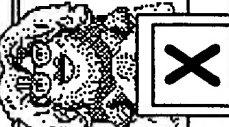
<div><b>Pay Table</b> <b>X Win</b> <b>50 CREDITS AND QUESTION ROUND</b></div> <div><b>Tie Game</b> <b>20 CREDITS AND CELEBRITY PICK</b> <b>© Win</b> <b>20 CREDITS</b></div>			<div>JOAN RIVERS  <b>O</b></div> <div>BRAD GARRETT  <b>X</b></div> <div>GEORGE WALLACE  <b>O</b></div>	<div>DON RICKLES  <b>X</b></div> <div>WHOOPI GOLDBERG  <b>X</b></div> <div>PAT MORITA  <b>O</b></div>	<div>PHYLLIS DILLER  <b>X</b></div> <div>GILBERT GOTTFRIED  <b>O</b></div> <div>BRUCE VILANCH  <b>X</b></div>	<div><b>HOLLYWOOD squares</b></div> <div>LINE BET <input type="text" value="1"/></div> <div>CREDITS <input type="text" value="887"/></div> <div>BONUS <input type="text" value="20"/></div> <div>PAID <input type="text" value="0"/></div>
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FIG. 14



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<div><b>Pay Table</b> X Win <b>50 CREDITS AND QUESTION ROUND</b> Tie Game <b>20 CREDITS AND CELEBRITY PICK</b> © Win <b>20 CREDITS</b></div>			<div><b>SELECT AN X SQUARE TO REVEAL A BONUS</b></div>		
<div>JOAN RIVERS</div>	<div>BRAD GARRETT</div>	<div>GEORGE WALLACE</div>	<div>70b</div>	<div>70b</div>	
<div>DON RICKLES</div>	<div>WHOOPI GOLDBERG</div>	<div>PAT MORITA</div>			
<div>PHYLLIS DILLER</div>	<div>GILBERT GOTTFRIED</div>	<div>BRUCE VILANCH</div>			
LINE BET		CREDITS	BONUS	PAID	
7		887	20	0	

HOLLYWOOD squares

FIG. 15



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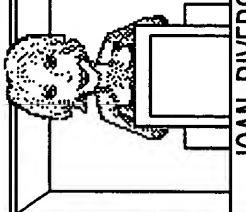
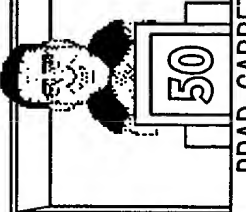
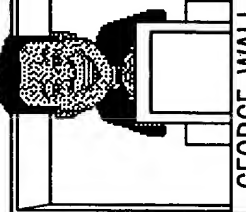
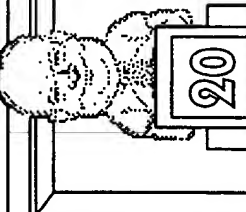
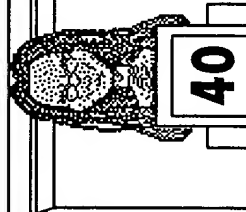
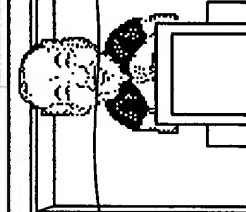
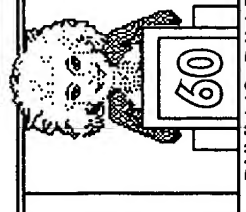
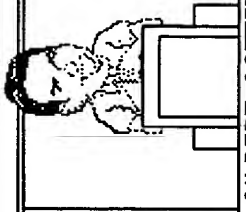
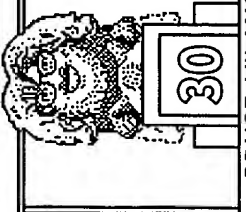
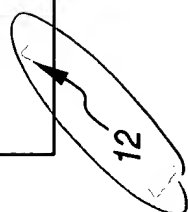
<b>Pay Table</b> <b>X Win</b> <b>50 CREDITS AND QUESTION ROUND</b> <b>Tie Game</b> <b>20 CREDITS AND CELEBRITY PICK</b> <b>© Win</b> <b>20 CREDITS</b>			<b>JOAN RIVERS</b>  <b>50</b>			<b>BRAD GARRETT</b>  <b>50</b>			<b>GEORGE WALLACE</b>  <b>50</b>					
<b>40 CREDITS WON</b>			<b>DON RICKLES</b>  <b>20</b>			<b>WHOOPI GOLDBERG</b>  <b>40</b>			<b>PAT MORITA</b>  <b>30</b>					
<b>PHYLLIS DILLER</b>  <b>60</b>			<b>GILBERT GOTTFRIED</b>  <b>30</b>			<b>BRUCE VILANCH</b>  <b>30</b>			<b>70b</b>					
<b>HOLLYWOOD squares</b>			<b>LINE BET</b> <b>7</b>			<b>CREDITS</b> <b>887</b>			<b>BONUS</b> <b>60</b>			<b>PAID</b> <b>0</b>		

FIG. 16





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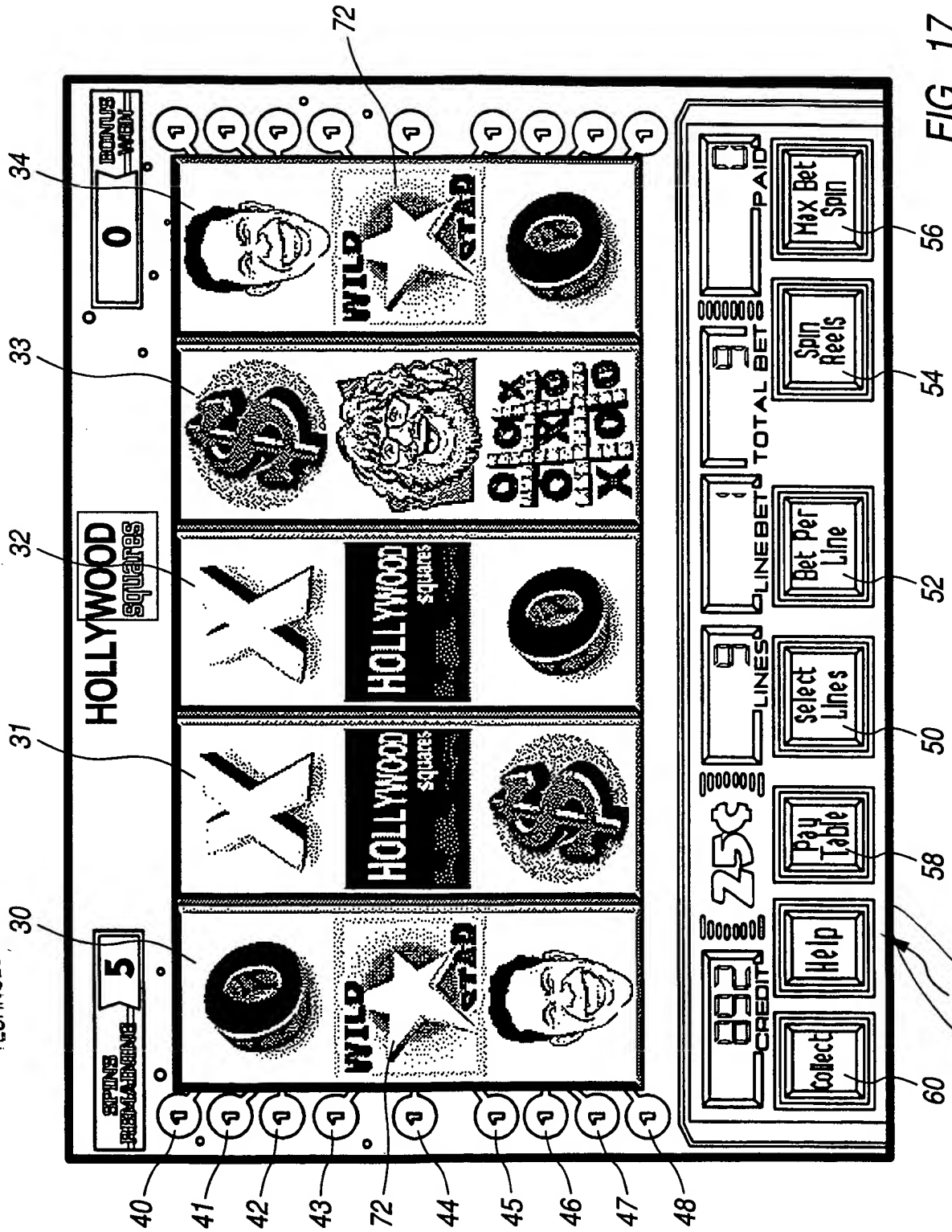


FIG. 17



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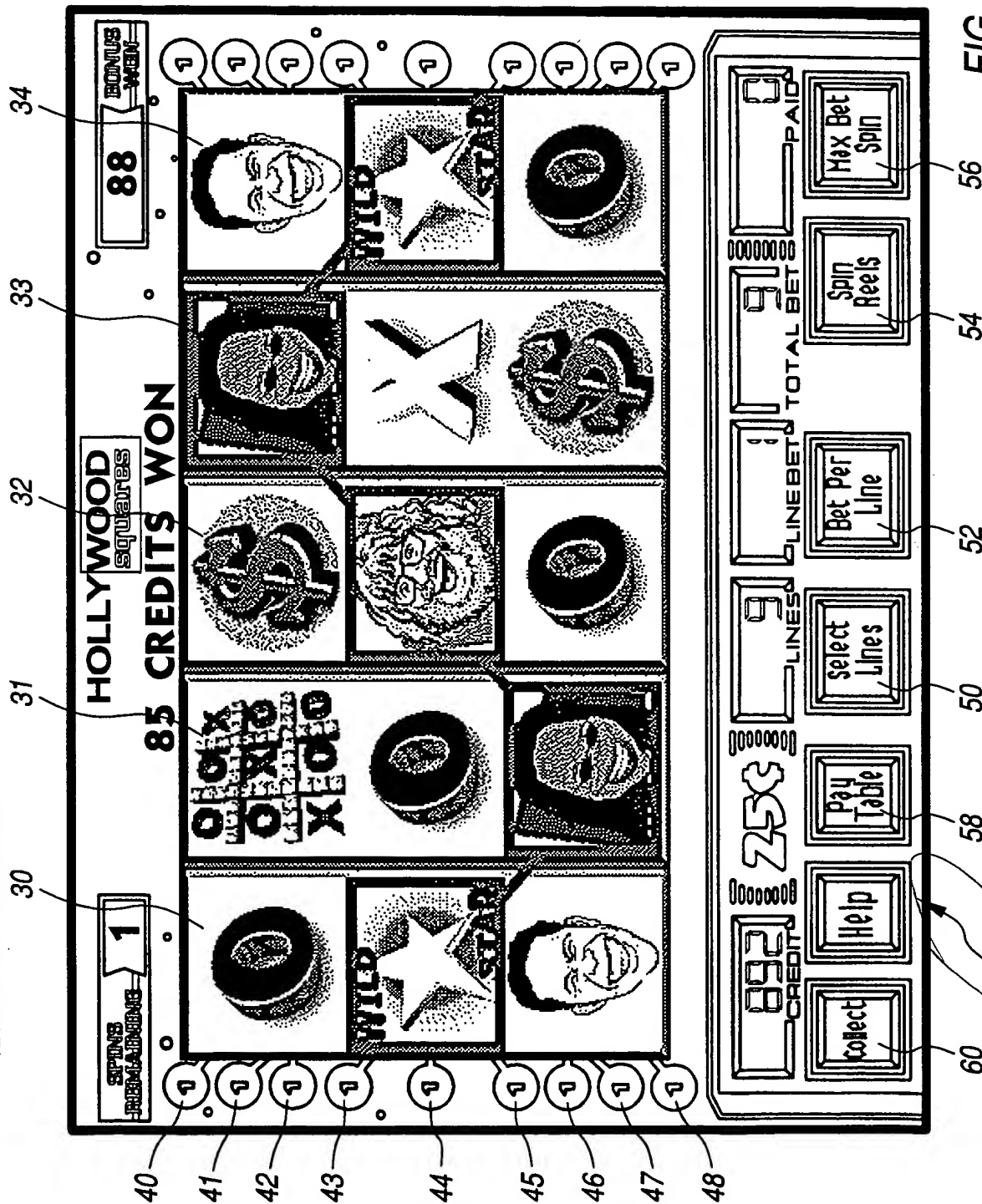


FIG. 18

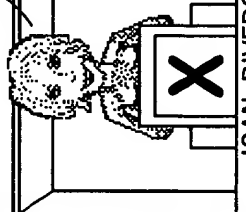


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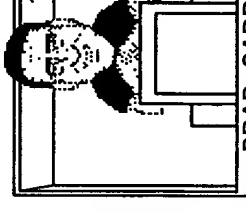
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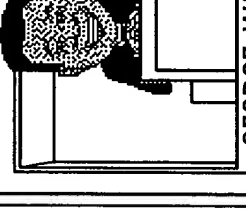
82a

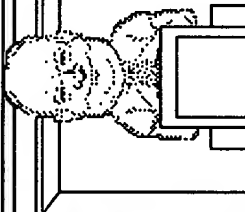
  
JOAN RIVERS

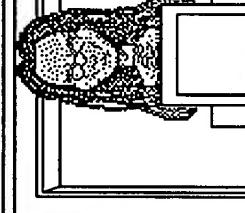
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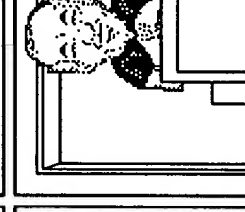
  
BRAD GARRETT

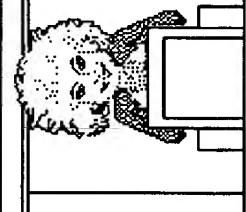
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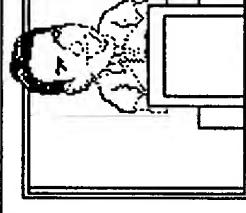
  
GEORGE WALLACE

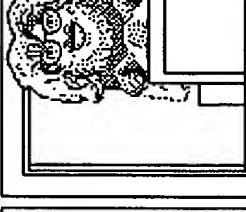
  
DON RICKLES

  
WHOOPI GOLDBERG

  
PAT MORITA

  
PHYLLIS DILLER

  
GILBERT GOTTFRIED

  
BRUCE VILANCH

**Question**  
The Hollywood sign  
is a worldwide  
symbol of the  
movies but it  
originally said what

**Answer**  
Tinseltown

**A  
CORRECT  
ANSWER  
EARNS  
AN X**

**HOLLYWOOD**  
squares

LINE BET

CREDITS

BONUS

PAID

FIG. 19